Remarks

Claim Interpretation

The Examiner erroneously asserts that the a number of claim elements do not distinguish the claimed apparatus from the prior art. This assertion is not "claim interpretation," but rather the Examiner's assertion regarding obviousness or novelty, and does NOT belong under a separate heading.

Further (but not finally) the recitation of a claim element such as "when the lid is inserted into the area between the gripping jaws, it is held by the gripping jaws through frictional contact" is a valid claim limitation which should be taken into account, and not summarily dismissed in a separate discussion of "claim interpretation." For example, a reference in which a lid is held by the insertion of edges on the gripping jaws in between serrations in the lid would be distinct from the claim recitation, as it is not "frictional contact" which holds the lid, but rather the mechanical interaction of the edges and serrations. However, such an argument is not a part of "claim interpretation," but rather an argument regarding the mistaken application of 35 U.S.C. § 102.

Claim Rejections under 35 U.S.C. § 102(b)

The Office Action rejects claims 1-5 under 35 U.S.C. § 102(b) over Burt et al. (US4674340) and over Besnier (US5533407).

In response to our previous arguments, the Examiner asserted that both Besnier and Burt et al. teach the frictional holding by the gripper, stating that "the devices of Besnier and Burt et al. would not be able to perform the function of opening and/or closing of the lids/caps of the vessels/tubes and the gripper." Applicants respectfully disagree. In addition, while the Examiner asserts that the Applicants arguments have been considered, the Applicants must respectfully point out that, from the Examiner's version of many of our arguments, the Examiner must not have actually understood our arguments, and thus could not have fully considered them.

With regard to Burt, the reference explicitly states in column 3, lines 51-56 that "When a hollow, cup shaped device 74 is placed over a threaded cap on a container, the edges 88 will be located between serrations on the threaded cap so as to prevent relative rotation between the

hollow, cup shaped device 74 and the threaded cap." Thus, it is not friction that performs the opening and closing of the cap in Burt, but the mechanical interaction between the edges 88 of the cup shaped device and the serrations on the threaded cap. The disclosure in Burt does not rely on frictional contact for the opening/closing of the lids/caps of the vessel/tubes and the gripper.

Further, the Examiner asserts that, "in view of the claim interpretation, the currently presented claim 1 does not structurally limit the gripper to a gripper that exerts frictional force to the lid of the vessel." With all due respect to the Examiner, that structural limitation is precisely what the phrase "held by the gripping jaws through frictional contact" does. The Examiner cannot invalidate this claim limitation simply by erroneously choosing to ignore this language.

The Examiner also states the the applicant argues in paragraph 5 of page 7, the "Burt et al. do not explicitly disclose the "closing" the lids/caps of the vessels/tubes." The Applicants are very confused, and propose that the Examiner is grossly misinterpreting the Applicants's arguments, or is reading the wrong response. In our previous response, paragraph 5 of page 7 reads:

> "In column 3, lines 51-56, Burt et al. discloses a device wherein edges 88 located between serrations on the threaded cap actuate opening (closing is not mentioned). In other words, caps are fitted with serrations and edges 88 of the gripping device engage theses serrations. This fails to meet the limitations of claim 1 which requires that "when the lid is inserted into the area between the gripping jaws, it is held by the gripping jaws through frictional contact". In Burt et al. the mechanical engagement of the edges 88 between the serrations on the threaded cap is distinct from the frictional contact required by the wording of claim 1. Therefore, Burt et al. fails to teach a device that anticipates the device of claim 1."

The previous is an argument that Burt et al. do not disclose a device in which the lid is held by the gripping jaws through frictional contact. This argument is still valid and has NOT been addressed adequately by the Examiner. This argument has nothing to do with whether Burt et al. disclose the "closing" of lids/vessels. We respectfully request the Examiner reread the previous Response, and elucidate his claim regarding our arguments.

With respect to Besnier, the Examiner asserts that "it is element 106 that is equivalent to the jaws in the rejections above." And that "element 108 would be the webs" and "(t)he gripper(76) of Benier does not actively operate the gripping jaws."

Again, with the greatest of all due respect, the Applicants respectively assert that the Examiner has missed our argument entirely. Whether the gripper (76) of Besnier does or does not actively operate the gripping jaws (106) is immaterial to the argument.

As stated in the last response:

> "As for Besnier, it discloses an active gripping device with pivoting noses 108 for gripping of the jug's cap. Tightening/loosening of the pivoting noses 108 is controlled by vertical displacement of yoke 112 by screwing on threaded rod 109 (see in particular yoke 112 and pivoting nose 108 in Fig. 6 in Besnier). Column 7, lines 28-47 of Besnier describes the interaction of yoke 112 trapped between the noses 108 by displacement of yoke 112. Thus, opening/closing of caps is done by a gripper which is an active operating device composed of noses 108 which are tightened/loosened around the cap and rotated for opening/closing of the jug. Conversely, the wording of claim 1 specifically excludes gripper having active operating device.
>
> The wording of claim 1 further requires that: "when the lid is inserted into the area between the gripper jaws, it is held by the gripping jaws through frictional contact". Besnier fails to teach a device that meets this requirement. Besnier teaches a device in which the cap of the jug is held by the gripper through tightening of the noses 108. The tightening of the noses 108 is a mechanical actuation distinct from not frictional contact. Therefore, Besnier does not teach a devices that anticipates the device of claim 1."

In Besnier, it is element 108 which engages and comes in contact with the lid/cap of the vessel/tube. Thus, because element 108 is what comes into contact with the lid, it is operational the equivalent to the gripping jaws of the claimed invention. Because there is, in fact, an active operating device for opening and closing the element 108 (the equivalent of the gripping jaws of the claimed invention), which are elements 109 and 112, Besnier fails to disclose a device with a gripper wherein "the gripper has no active operating device for opening and closing the gripping jaws."

The Examiner is merely attempting to rename the "gripping jaws" of the device in Besnier in order to skirt the claim recitation of "the gripper has no active operating device for opening and closing the gripping jaws." Thus, the Examiner has failed to show that Besnier anticipates the claimed invention of claim 1.

Applicant respectfully submits that both documents fail to disclose opening and closing reaction vessels through frictional contact.

Reconsideration and withdrawal of the rejections of claims 1-5 under 35 U.S.C. § 102(b) over Burt et al. (US4674340) and over Besnier (US5533407) under is therefore respectfully submitted.

Claim Rejections under 35 U.S.C. § 103(a)

The Office Action rejects claims 6-11 under 35 U.S.C. § 103(a) over Burt (US4674340) or Besnier (US5533407) in view of Marino (US6132684).

The Office Action states that, regarding claims 6-8 and 11, Burt et al. / Besnier disclose all of the limitations. Applicant respectfully disagrees for the reasons given hereinabove. As explained above, both Burt et al. and Besnier fail to teach the claimed invention. Marino fails to make up for the inadequacies of Burt et al and Besnier.

Further, the Examiner states that the "Applicant did not argue why modifying the device of Besnier and Burt et al. with Marino would be improper." The argument that applicants made was that Marino FAILS to rectify the inadequacy of Burt and Besnier, thus the issue of whether the modification of Burt and Besnier with Marino is moot.

The Office Action acknowledges that Burt et al. and Besnier fail to teach the holding device claimed in claims 6-11. The Office Action further states that Marino discloses a holding apparatus for holding resilient plastic tubes comprising the limitations of the device of claim 6.

In fact, as explained above, one of the main differences with the devices taught by Burt et al./Besnier is that when the lid is inserted into the area between the gripping jaws, it is held by the gripping jaws through frictional contact.

The Examiner states that the "issue of frictional contact is discussed above." As previously mentioned, the Examiner's assertion is entirely incorrect for the reasons stated above.

As stated previously, there is no motivation to modify the opening/closing system of Besnier/Burt et al. to conform the opening/closing system of the device of the invention either. In fact, the devices taught in Besnier/Burt et al. work according to different principles of operation.

The Examiner claims to have fully considered the argument in the last paragraph on page 9 of the previous Response. The Examiner claims that "element 88 of Burt et al is capable of holding the lid of a vessel even when the gripper is lifted above the vessel." A complete reading of Burt et al. reveals that the device disclosed in Burt et al. is not designed to lift a cap off and hold a cap, but to turn a cap until it is loosened and record the torque required to loosen the cap. Because the device in Burt et al relies on the mechanical interaction between the edges of the gripper and the serrations on the cap, it does NOT rely on "frictional contact," nor does it disclose a device which requires any significant "frictional contact" between the gripping jaws and the lid/cap in order to work in the manner required by Burt et al.

As stated in the previous Response:

> "The principle of operation of the device taught by Besnier is that a cap is removed and put back in place on the jug by active mechanical means (tightening/loosening of gripper noses 108) that can be actuated and controlled. With this configuration, the cap can be removed and put back in place depending on the actuation of the gripping jaws. A modification of the device taught in Besnier to have the caps removed by gripping jaws wherein they are held by frictional contact would not be seen as advantageous because it would mean loosing the control of the gripping jaws. Therefore, there would be no motivation to replace the active gripping means of the device of Besnier by the non active gripping means of the invention and the device of the invention cannot be considered as obvious over Besnier.
>
> The device taught by Burt et al. requires caps with serrations that are only meant to be unscrewed and not put back in place on the recipients. Once the caps are unscrewed, they fall from the hollow cup shaped device which is then empty and ready for unscrewing the next recipient. The fact that a cap may be stuck in the hollow cup shaped device is highly unwanted, because it would not allow unscrewing the next

recipient. Conversely, in the device according to the invention, the lids are held in the gripper jaws by frictional contact and stay in place until they are screwed back on the vessels. They are not discarded. Therefore, replacing the hollow cup shaped device of Burt et al. by the gripper jaws of the device according to the invention would render the device of Burt et al. so modified unsatisfactory for its intended purpose, because it would no longer allow unscrewing recipients after the first recipient is unscrewed. The gripper would be obstructed by a lid held in place by frictional contact and would not be able to unscrew yet another recipient. MPEP 2143.01.V states that if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Therefore, there would be no motivation to modify the device taught by Burt et al. and the device of the invention cannot be considered as obvious over Burt et al."

Thus, not only does Marino fail to rectify the deficiencies of Burt et al. and Besnier, the modification of Burt et al. and Besnier with Marino would, as clearly stated, be improper.

Applicant therefore respectfully requests reconsideration and withdrawal of the rejection of claims 6-11 under **35 U.S.C. § 103(a)** over Burt (US4674340) or Besnier (US5533407) in view of Marino (US6132684).

The Office Action also rejects claims 9 and 10 under **35 U.S.C. § 103(a)** over Burt (US4674340) or Besnier (US5533407) in view of Marino (US6132684), and further in view of Hansen et al. (US2003/0038071).

Claims 9 and 10 depend on claim 6 and the remarks made with regard to claim 6 over Burt (US4674340) or Besnier (US5533407) in view of Marino (US6132684) also apply to claims 9 and 10.

As stated previously, Burt et al. and Besnier fail to anticipate the claimed invention of claims 1-5. Hansen et al. does not cure the defects of Burt et al. and Besnier. Therefore, claims 9 and 10 cannot be considered as obvious over these references either.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 6-11 under **35 U.S.C. § 103(a)** over Burt (US4674340) or Besnier

(US5533407) in view of Marino (US6132684) and further in view of Hansen et al. (US2003/0038071).

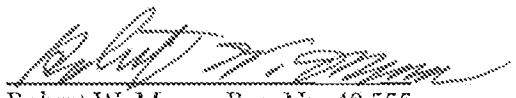
Conclusion

Pending claims are believed to be in condition for allowance and issuance of a Notice of Allowance is respectfully requested. The shortened statutory period of three months originally set for responding to the Office Action expired on October 27, 2009. A three-month extension of time is therefore requested. The extension of time resets the deadline for responding to January 27, 2010. The Commissioner is authorized to charge the corresponding fee under 37 CFR 1.17(a)(2) to Account No. 50-0812. No other fee is believed to be due at this time, however, the Commissioner is authorized to charge any fee deficiency, or credit any overpayment, to Deposit account No. 50-0812.

If the Examiner believes that a telephone conference would expedite prosecution of this application, he is asked to telephone the undersigned directly at 925-730-8560.

Respectfully submitted,

Date: January 27, 2010



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